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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/511,362  | 02/23/2000  | Kevin Sullivan       | 47004.000067        | 4127             |
| 21967   | 7590        | 04/21/2004           | EXAMINER            |                  |
| HUNTON & WILLIAMS LLP<br>INTELLECTUAL PROPERTY DEPARTMENT<br>1900 K STREET, N.W.<br>SUITE 1200<br>WASHINGTON, DC 20006-1109 |             |                      | BASHORE, ALAIN L    |                  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 3624                 |                     |                  |
| DATE MAILED: 04/21/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                  |                 |
|------------------------------|------------------|-----------------|
| <b>Office Action Summary</b> | Application No.  | Applicant(s)    |
|                              | 09/511,362       | SULLIVAN, KEVIN |
|                              | Examiner         | Art Unit        |
|                              | Alain L. Bashore | 3624            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 October 2003 and 16 January 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 14,15 and 29-59 is/are pending in the application.

4a) Of the above claim(s) 54-59 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 14,15 and 29-53 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "encourage" is considered a relative term. What is encouragement to one may not be encouragement to another.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-15, 29-53 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the preamble and

body of the claim structural / functional interrelationships that are solely by computer (and non-trivial) are considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-15, 29-30, 32-35, 37, 39-40, 42-44, 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458).

Fernandez-Holtsmann discloses establishing a credit card account as a card payment instrument account having a rebate feature, establishing an investment account (inherently including “activation” per se) for the benefit of the approved cardholder (col 4, lines 45-46), calculating a rebate as a percentage of the net purchases periodically as a percentage of net-purchases, and funding the investment account with the rebate (col 5, lines 48-67; col 6, lines 1-20). A statement is issued (fig

5). Separate institutions are disclosed for the credit card and investment account (col 2, lines 28-33). The investment account may be an existing account (col 4, lines 45-51). Fernandez-Holtsmann also discloses funding the rebate as shared with the credit card account provider providing the credit card account (col 4, lines 20-34).

Since the method to Fernandez-Holtsmann discloses step S2 occurring after step S1 (see fig 1) there is discloses a "new" investment account established as a result of the credit card account provider to set-up the new account fund account for the benefit of the approved cardholder.

Fernandez-Holtsmann does not disclose:  
the statement including an offer to activate an investment fund account to be funded with the rebate and the acceptance of the offer;  
rebates accrue (as aggregated) according to a first period (monthly), and wherein the rebate can vest to be applied to the investment account according to a second period; and,  
issuing a statement to the cardholder including calculated rebate, rebate value applied to the investment account, accrued rebate value not yet vested to be applied to the investment account.

Feidelson et al discloses rebates accrue (as aggregated) according to a first period (monthly), and wherein the rebate can vest to be applied to the investment

account according to a second period (col 11, lines 31-44), and issuing statements to the cardholder (col 12, lines 54-64).

It would have been obvious to one with ordinary skill in the art to include to Fernandez-Holtsmann rebates accrue according to a first period (monthly), and wherein the rebate can vest to be applied to the investment account according to a second period for administrative purposes (i.e. minimums required) as taught by Feidelson et al (col 9, lines 64-67; col 10, lines 1-2; col 11, lines 31-44).

It would have been obvious to one with ordinary skill in the art to include to Fernandez-Holtsmann issuing statements to the cardholder including calculated rebate, rebate value applied to the investment account, accrued rebate value not yet vested to be applied to the investment account all because Feidelson et al teaches information dissemination (col 12, lines 54-67).

Walker et al (458) discloses a statement including an offer to activate an offer to be funded with the rebate and the acceptance of the offer (col 2, lines 45-67; col 3, lines 1-20).

It would have been obvious to one with ordinary skill in the art to include a statement including an offer to activate an investment fund account to be funded with the rebate and the acceptance of the offer because Walker et al teaches added offers on a billing statement may result in added consumer activity (col 1, lines 54-56).

7. Claims 31, 36, 41, 46, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458) as applied to claims above, and further in view of Sullivan.

Sullivan discloses a vesting period that is semi-annually or annually (col 6, lines 32-37) and percentage as variable based on cardholder loyalty (col 6, lines 1-18).

It would have been obvious to one with ordinary skill in the art to include a second period of semi-annually or annually because Sullivan teaches long periodic vesting periods as advantageous to the investment (col 6, lines 32-37).

It would have been obvious to one with ordinary skill in the art to include the percentage as variable based on cardholder loyalty because Sullivan teaches variability because of investment linkage (col 6, lines 1-18).

8. Claims 35, 45, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458) as applied to claims above, and further in view of Simpson.

Simpson discloses funding the rebate as shared with the investment account provider (col 3, lines 20-25).

It would have been obvious to one with ordinary skill in the art to include funding the rebate as shared with the investment account provider because Simpson teaches costs associated with investment account initial startup (col 3, lines 20-25).

9. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holtsmann in view of Feidelson et al in further view of Walker et al (458) as applied to claims above, and further in view of Kalina (688).

Kalina discloses "automatic" establishment of a new investment account (col 1, lines 15-20; col 6, lines 20-25).

It would have been obvious to one with ordinary skill in the art to automate establishment of the new investment account upon acceptance of the offer for purposes of convenience and in view of *In re Venner et al* (120 USPQ 192) that teaches that automatic provision is not patentably distinct.

***Election/Restrictions***

10. Applicant's election of Claims 14-15, 29-53 in Paper No. 14 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 54-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Response to Arguments***

11. Applicant's arguments with respect to claims of record have been considered but are moot in view of the new ground(s) of rejection.

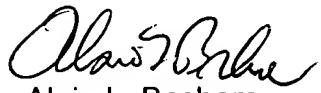
***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:00 am to 4:30 pm (Monday thru Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alain L. Bashore



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| APPL NO.   | FILING OR 371<br>(c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
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| 09/511,362 | 02/23/2000                | 3624     | 1132          | 47004.000067   | 4        | 28       | 4        |

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CONFIRMATION NO. 4127  
**CORRECTED FILING RECEIPT**



\*OC000000012392226\*

Date Mailed: 04/19/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

**Applicant(s)**

Kevin Sullivan, Wilmington, DE;

**Domestic Priority data as claimed by applicant****Foreign Applications****If Required, Foreign Filing License Granted:** 05/02/2000**Projected Publication Date:** None, application is not eligible for pre-grant publication**Non-Publication Request:** No**Early Publication Request:** No**Title**

Mutual fund card method and system

**Preliminary Class**

705

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Title 37, Code of Federal Regulations, 5.11 & 5.15**

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**NOT GRANTED**

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